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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,903	02/01/2005	Stephanie Frahn	264742US0X PCT	7011
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
RONESL VICKERY M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/26/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/522,903

Applicant(s)

FRAHN ET AL.

Examiner

VICKEY RONESI

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date 7/17/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/17/2008 has been entered.
2. The outstanding 35 USC 112, 2nd paragraph rejections are withdrawn in light of applicant's amendment filed on 7/17/2008.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Election/Restrictions

5. Applicant's election with traverse of the restriction in the reply filed on 7/17/2008 is acknowledged. The traversal is on the ground(s) that the claims drawn to a silanized, structurally modified pyrogenic silica are not distinct from claims drawn to a composition comprising the silanized, structurally modified pyrogenic silica. This is not found persuasive because the silanized, structurally modified pyrogenic silica fails to define a contribution over the prior art (see "Bock" below) and therefore the technical relationship does not amount to a special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

6. Claim 2-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,020,419 (hereinafter, "Bock").

The rejection is adequately set forth in paragraph 6 of Office action mailed on 3/17/2008 and is incorporated here by reference.

Double Patenting

7. Applicant's statement on page 10 of the amendment filed 7/17/2007 regarding the provisional obviousness-type double patenting rejections is acknowledged. If the following double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Double Patenting, I

8. Claims 2, 3, 5, and 10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 10/524,472 (published as US 2005/0244642).

The rejection is adequately set forth in paragraph 8 of Office action mailed on 3/17/2008 and is incorporated here by reference.

9. Claims 2, 3, 5, and 10 are directed to an invention not patentably distinct from claim 15 of commonly assigned copending Application No. 10/524,472 (published as US 2005/0244642).

The discussion in paragraph 9 of Office action mailed on 3/17/2008 is incorporated here by reference.

Double Patenting, II

10. Claim 1, 8, and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 and 18 of copending Application No. 10/524,366 (published as US 2005/0241531).

The rejection is adequately set forth in paragraph 10 of Office action mailed on 3/17/2008 and is incorporated here by reference.

11. Claim 1, 8, and 9 are directed to an invention not patentably distinct from claims 17 and 18 of commonly assigned copending Application No. 10/524,366 (published as US 2005/0241531).

The discussion in paragraph 11 of Office action mailed on 3/17/2008 is incorporated here by reference.

Response to Arguments

12. Applicant's arguments filed 7/17/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that "structurally modified" is a term well known

in the term; (B) that Bock does not disclose “structurally modified” pyrogenic silica; and (C) that the instant invention provides for unexpectedly improved scratch resistance

With respect to argument (A), applicant cites Meyer ‘531, Meyer ‘642, Nargiello, and Hartmann as evidence, however, these are not convincing given that Meyer ‘531, Meyer ‘642, Nargiello, and Hartmann are all owned by the present assignee and therefore cannot serve to establish the ordinary and customary term of the art. There is no indication on the record that establishes that any person of ordinary skill outside of the Degussa family refers to “structurally modified” as silica that is subject to ball milling. Evidence to support the examiner’s position is found in Mort et al (US 4,613,556) which teaches that silicon oxide can be structurally modified by exposure to energetic radiation (col. 12, lines 10-12) or in Sands et al (US 5,001,183) which teaches structuring silica by acidifying silica (col. 4, lines 8-16). Furthermore, the specification does not elaborate on what type of structural modification is being performed, i.e., is it chemical or physical?

With respect to argument (B), while the instant claims recite “structurally modified” silica, it is not made clear how “structurally modified” silica is different from the silica taught by Bock or why the pyrogenic silica of Bock is not structurally modified. Bock teaches that the silica is prepared by jet dispersion, and it is the examiner’s position that this process causes the silica to be “structurally modified” due to the deagglomeration of silica agglomerates. Furthermore, the specification does not elaborate on how the instant silica is “structurally modified.”

With respect to argument (C), the data in the specification cannot establish unexpected results for several reasons. First, it has not been established how “structurally modified” silica differentiates itself from the silica of Bock. See discussion above.

Second, evidence of secondary considerations is irrelevant to 35 USC 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Third, the data is not reasonably commensurate in scope with the scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the type of polymer composition in the lacquer (i.e., acrylic copolymer) is not commensurate in scope with the scope of the claims. Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978). Furthermore, the relative amounts binder and silica are not reasonably commensurate in scope. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d).

Conclusion

13. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/21/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796